Paper No. 21

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Ex parte CRAIG S. BENDER and JOHN J. SHEDLETSKY

Appeal No. 1998-1853
Application No. 08/397,292

ON BRIEF

Before THOMAS, BARRETT and LALL, Administrative Patent Judges LALL, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134 from the Examiner's final rejection of claims 1 to 3, 5, 13, 14, 16, 25 to 27, 30 and 31, which constitute all the pending claims in this application.

The invention relates to an expert system for selecting, from a predetermined set, a computer solution comprising a front end platform, a back-end platform and a communication facility

linking the platforms together. The system stores descriptions or diagrams of the set of respective pre-defined computer solutions. The system directs display of different uses of the computer solutions, and a user selects one or more of the uses. In response, the system identifies a subset of the computer solutions corresponding the selected use(s). The invention is further illustrated below by the following claim.

> 1. An expert system for determining a computer solution, said system comprising:
>
> means for storing descriptions or diagrams of a set of respective pre-defined computer solutions, each of said computer solutions comprising a front end platform, a back-end platform and a communication facility linking said platforms together;
>
> means for directing display of different uses of said computer solutions; and
>
> means, responsive to user selection of one or more of said uses for identifying a subset of said computer solutions corresponding to the selected uses.

The examiner relies on the following references:

Dworkin	4,992,940	Feb. 12, 1991
Maki et al. (Maki)	5,201,047	Apr. 06, 1993
Quentin et al. (Quentin)	5,208,745	May 04, 1993

R. Cowart, “Mastering Windows™ 3.1" Sybex Inc.,

chapter 1, pp. 5-8, and 38 (1993). (Windows™)

Claims 1, 13, 25, 30 and 31 stand rejected under 35 U.S.C. § 103 as being unpatentable over Dworkin and Maki. Claims 2, 3, 14, 16, 26 and 27 stand rejected under 35 U.S.C. § 103 as being unpatentable over Dworkin, Maki and Quentin, while claim 5 stands rejected under 35 U.S.C. § 103 as being unpatentable over Dworkin, Maki and Windows™.

Rather than repeat the positions and the arguments of appellants and the examiner, we make reference to the briefs[1] and the answer for their respective positions.

OPINION

We have considered the rejections advanced by the examiner. We have, likewise, reviewed appellants' arguments against the rejections as set forth in the briefs. It is our view that the rejections under 35 U.S.C. § 103 are not proper. Accordingly, we reverse.

[1]A reply brief was filed (paper no. 18), which was considered and entered by the examiner without any further response. (See paper no. 20.)

In our analysis, we are guided by the general proposition that in an appeal involving a rejection under 35 U.S.C. § 103, an examiner is under a burden to make out a prima facie case of

obviousness. If that burden is met, the burden of going forward then shifts to the applicant to overcome the prima facie case with argument and/or evidence. Obviousness is then determined on the basis of the evidence as a whole and the relative persuasiveness of the arguments. See In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cit. 1992); In re Hedges, 783 F.2d 1038, 1039, 228 USPQ 685, 686 (Fed. Cit. 1986); In re Piasecki, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984); and In re Rinehart, 531 F.2d 1048, 1052, 189 USPQ 143, 147 (CCPA 1976). We are further guided by the precedent of our reviewing court that the limitations from the disclosure are not to be imported into the claims. In re Lundberg, 244 F.2d 543, 113 USPQ 530 (CCPA 1957); In re Queener, 796 F.2d 461, 230 USPQ 438 (Fed. Cir. 1986). We also note that the arguments not made separately for any individual

claim or claims are considered waived. See 37 CFR § 1.192(a) and (c). In re Baxter Travenol Labs., 952 F.2d 388, 391, 21 USPQ2d 1281, 1285 (Fed. Cir. 1991) ("It is not the function of this court to examine the claims in greater detail than argued by an appellant, looking for nonobviousness distinctions over the prior art."); In re Wiechert, 370 F.2d 927, 936, 152 USPQ 247, 254 (CCPA 1967)("This court has uniformly followed the sound rule that an issue raised below which is not argued in that court, even of it has been properly brought here by reason of appeal is regarded as abandoned and will not be considered. It is our function as a court to decide disputed issues, not to create them.").

We first consider the rejection of claim 1 over Dworkin and Maki. After reviewing the position of appellants, brief at pages 3 to 5, and the position of the examiner, final rejection at pages 2 to 4 and answer at pages 3 to 6, we

conclude that the
examiner has not made out a prima facie case in rejecting the claim. We find that the examiner does not explain what constitutes the claimed different uses of the computer solutions in Dworkin and how the selection of a use provides a display of the solution subset for that use. If the examiner considers various vendors (Figure 1) as the various users, then the

selection of a vendor displays a menu which again requires an input from the user. Without the input from the user, Dworkin's
software program does not proceed further. We are at a loss to
understand how the examiner meets the claimed limitation of "means, responsive to user selection of one or more of said uses for identifying a subset of said computer solutions corresponding to the selected uses." We agree with

appellants, brief at page 4 that,

> Dworkin does not teach or even suggest the narrowing of selections of a computer solution based on uses of the computer solution. Rather, in Dworkin the user directly specifies a desired type of product or service such as hardware products, software products or soft-ware consultants.

Maki also relates to a different invention. Maki relates to an attribute-based classification and retrieval system. Maki does not disclose or suggest the claimed means recited above.

Therefore, the examiner has not made out a prima facie case in the rejection of claim 1 over Dworkin and Maki. The other independent claims, 13 and 25, each contain the same imitations.

Therefore, their rejection based on Dworkin and Maki cannot be sustained.

Regarding the dependent claims, for example claim 2, the examiner adds Quentin as further evidence. However, Quentin does

not cure the deficiency noted above. Therefore, the rejection based on Dworkin, Maki and Quentin (with respect to claims 2, 3, 14, 16, 26 and 27) also does not constitute a prima facie case of obviousness. Regarding claim 5, the examiner adds to the combination of Dworkin and Maki, another reference, i.e., Windows™. However, Windows™ also does not cure the deficiency noted above. Therefore, the rejection based upon Dworkin, Maki and Windows™ also does not constitute a prima facie case of obviousness.

In conclusion, we have not sustained the obviousness rejection of claims 1, 13, 25, 30 and 31 over Dworkin and Maki, of claims 2, 3, 14, 16, 26 and 27 over Dworkin, Maki and Quentin, and of claim 5 over Dworkin, Maki and Windows™.

Accordingly, the decision of the examiner rejecting

claims 1 to 3, 5, 13, 14, 16, 25 to 27, 30 and 31 under 35 U.S.C. § 103 is reversed.

REVERSED

JAMES D. THOMAS Administrative Patent Judge	)	
LEE E. BARRETT Administrative Patent Judge	)	BOARD OF PATENT APPEALS AND INTERFERENCES
PARSHOTAM S. LALL Administrative Patent Judge	)	

vsh

Appeal No. 1998-1853
Application No. 08/397,292

ARTHUR J. SAMODOVITZ
IBM CORPORATION
INTELLECTUAL PROPERTY LAW
1701 NORTH STREET N50/040-4
ENDICOTT, NY 13760